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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,246	01/16/2001	Sebastiaan Antonius Fransiscus Arnoldus Van Den Heuvel	NL000013	5178

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

NGUYEN, BRIAN D

ART UNIT PAPER NUMBER

2661

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/761,246

Applicant(s)

VAN DEN HEUVEL ET AL.

Examiner

Brian D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on the amendment filed 7/19/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: proposed drawing correction.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the **selected** information sections" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the **submitted** criterion" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 6, "the submitted criterion" in line 4 and "said submitted criterion" in line 5 have the same problem as claim 4.

Claim 11 recites the limitation "the transmission system" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 provides a method of transmitting a multiplex signal, but, since the claim does not set forth any steps involved in the method, it is unclear what method applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex*

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*parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102(a) as being anticipated by THOMSON multimedia (EP 0 963 115 A1).

Regarding claim 1, Thomson discloses a transmission system for transmitting a multiplex signal from a transmitter to a receiver via a transmission channel, in which the multiplex signal has a plurality of information sections comprising information about the multiplex signal, and in which the transmission system is provided with a return channel (140) from the receiver to the transmitter, wherein the receiver has section selection means for submitting a criterion for filtering information sections to the transmitter via the return channel and in that the transmitter has section filtering means for filtering information sections according to the submitted criterion and networking means for transmitting the information sections that satisfy the criterion (see abstract; figures 1 & 4; paragraphs 0017, 0024-0027, 0033-0036, and 0043-0045).

Regarding claim 2, Thomson discloses the use of at least one of positive and negative filtering (see figures 2 & 5; paragraphs 0024 & 0061).

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Regarding claims 4-5 and 9, Claims 4-5 and 9 are transmitter and receiver claims used in the system claim 1 with substantially the same limitations. Therefore, they are subject to the same rejection.

Regarding claims 5-6 and 10, Thomson discloses removing criteria from the collection (see updating the criteria information in paragraph 0023).

Regarding claim 11, claim 11 is a method claim that has substantially all the limitations of the respective system claim 1. Therefore, it is subject to the same rejection.

#### ***Allowable Subject Matter***

5. Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### ***Response to Arguments***

6. Applicant's arguments filed 7/19/04 have been fully considered but they are not persuasive.

The applicant argued that "*Thomson fails to teach show or imply at least the limitations of the receiver has section selection means for submitting a criterion for filtering information sections to the transmitter via the return channel and in that the transmitter has section filtering means for filtering information sections according to the submitted criterion and networking means for transmitting the information sections that satisfy the criterion, as recited in amended independent claim 1. The Office Action indicates that these limitations are disclosed in THOMSON in the abstract; figure 1; and paragraphs 0024-0025, 0033-0036. Applicants*

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*respectfully disagree. In these sections, THOMSON discloses that the (Broadcaster) transmits digital data with an attached filter. Then the receiver (interactive terminal) applies the script of the filter to the criteria in the filter and viewer profile to enable an interactive connection. Thus, THOMSON, in contrast the present invention, does not disclose or imply, that the transmitter uses a section filtering means to filter information sections according to the submitted criterion and networking means and then transmit the (filtered) information sections that satisfy the criterion to a receiver, as recited in amended claim 1.*" This argument is not persuasive because THOMSON's receiver does have a section selection means for submitting a criterion for filtering information sections to the transmitter via the return channel (see paragraphs page 2, lines 22-23 and page 3, lines 29-35 where the receiver submits a criterion to the transmitter). THOMSON's transmitter does have a section filtering means for filtering information sections according to the submitted criterion (see page 3, lines 54-55 where THOMSON discloses filtering by targeting a predefined subgroup of registered viewers; see page 6, lines 8-9 where THOMSON discloses filtering by selecting a particular profile to be broadcast; see page 8, line 56-page 9, line 5 and figure 4 where THOMSON teaches different receivers with different profiles, 1 and 2 for example, receive different messages). THOMSON does disclose networking means for transmitting the (filtered) information sections that satisfy the criterion to a receiver (THOMSON's working means is a means for transmitting the filtered information as described above in this paragraph). In addition, the attached filter transmitted to the receiver in THOMSON's system can also be considered the filtered information of the claimed invention because the attached filter is based on the criterion set by the receiver and the transmitter has to select an appropriate attached filter to be transmitted to the corresponding receiver. In other

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words, THOMSON's transmitter must have a section filtering means to select an appropriate attached filter (filtered information) to be transmitted to the corresponding receiver.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

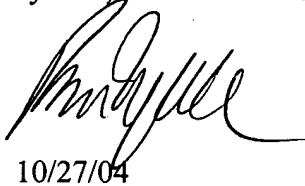
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Nguyen whose telephone number is (571) 272-3084. The examiner can normally be reached on 7:30-6:00 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



10/27/04

**BRIAN NGUYEN**  
**PRIMARY EXAMINER**